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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,100

10/25/2006

Immanuel Straub

516/12

6349

27538 7590 07/08/2010

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EXAMINER

EASTWOOD, DAVID C

ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

07/08/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/591,100</p>	<p>Applicant(s) STRAUB, IMMANUEL</p>	
	<p>Examiner David Eastwood</p>	<p>Art Unit 3731</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 June 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 26-49.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Gary Jackson/
Supervisory Patent Examiner Trainer
TC 3700
July 6, 2010

/D. E./
Examiner, Art Unit 3731
7/3/2010

Continuation of 11. does NOT place the application in condition for allowance because: The Examiner would like to initially note with regard to Applicant's arguments directed to the Examiners interpretation of certain words in the claims as stated in the after final remarks and amendments submitted on 5/10/201 that it has been held that during examination, the claims must be interpreted as broadly as their terms reasonably allow. In re American Academy of Science Tech Center, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). See also MPEP 2111.01 [R-5]. In the instant case Applicant has continued to allege that the prior art of record fails to disclose an end wall capping the cylindrical bore at the distal end of the working head citing that the prior art of record used to reject this limitation fails to disclose said limitation and that the examiners definition of the word cap as cited by the examiner is inconsistent with applicants interpretation of the claim language. The Examiner respectfully disagrees with Applicants assertions. The term cap as defined in the office action merely recites a position of an element, therefore when describing a series of elements and their positional relationship relative to one another it would be completely reasonable to state that the distal end wall of element 14 is capping or positioned at the distal end of the cylindrical bore. The term "capping" is reciting a position of an element in relation to other elements and does not impose a structural limitation on the claim but merely the position of a structure within the claimed device, see definition of the word cap as provided on page 3 of the outstanding office action and therefore meets the limitation as set forth in at least claims 26, 47 and 48.

Applicant further alleges that the disclosure of Straub et al. fails to disclose that a distal end of the transport screw abuts said end wall and that the flexible transport screw has a distal end configured to rotate relative to said end wall. The Examiner again respectfully disagrees. The term abut is defined as "to be adjacent to; border on; end at". (abut. (n.d.). Dictionary.com Unabridged. Retrieved May 12, 2010, from Dictionary.com website: <http://dictionary.reference.com/browse/abut>) As can be clearly seen in at least figures 6 and 7 element 32 is at least adjacent to element 14 if not in contact with since element 32 lies within element 14 and therefore "abuts" the aforementioned end wall of element 14. Furthermore, the Straub reference clearly states in C4 L1-15 that element 32 and rotor 16 are fixed to one another and rotate relative to end wall element 14 therefore flexible transport screw element 32 rotates relative to the end wall portion of element 14 thus meeting the limitations of at least claims 26, 47 and 48. Applicant goes on to state that the Straub reference fails to disclose that the flexible transport screw has "sharp" edges. The word "sharp" is defined as "terminating in an edge or point; not blunt or rounded" (sharp. (n.d.). Dictionary.com Unabridged. Retrieved May 12, 2010, from Dictionary.com website: <http://dictionary.reference.com/browse/sharp>) As can be clearly seen in fig. 8 the flexible transport screw has a rectangular cross-section whose perimeter surfaces terminate in an edge. see fig. 8 and cross-section of element 32 denoted 32c. Applicant further proffers that the combination of the Straub and Kocak references with respect to claims 26 and 47 and the combination of the Straub, Kocak and Evans references with respect to claim 48 fail to disclose "said helix having an external diameter fitting the diameter of said cylindrical bore to rotate therein in contact therewith". The Examiner has previously noted that this limitation is clearly disclosed in the cross-sectional view of figures 7 and 8 of the Straub reference as well as disclosed in a cross-sectional view take transverse to the longitudinal axis of fig. 5 note the contact of edge 32 with the inner diameter of the bore depicted in at least figures 5, 7 and the diameter and structure disclosed in figure 8. Applicant has further proffered that the prior art of record fails to disclose "internal edges in contact with said flexible transport screw distal part edges to shear and comminute material". This is not only disclosed in the structure and operation of Straub as mention in the office action p4 L10-12 which points out that as screw 32 and rotor 16 rotate fixed to one another the screw 32 comes into contact with shearing surfaces 14 a,b,c, also note fig. 3,5, 6 and 7, and is capable of shearing tissue which may fall between the screw and the aforementioned shearing surface, but also is disclosed in C4 L1-7 of Straub with regard to the comminute limitation. Applicant is also reminded that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) as well as a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)